

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-99 are pending in the application. Upon entry of this Amendment, claims 2-5, 35-47, 52, 53, 55-60, 68-70, and 84-92 will be cancelled, without prejudice or disclaimer, and claims 1, 6, 21, 48, 50, 54, 71, 98 and 99 will be amended, and new claims 100-255 will be added.

On January 7, 2004, the Examiner issued an Office Communication advising that the status identifier, *i.e.*, "Amended", used with claims 1, 67, 21, 50, 54, 71 and 99 in the Amendment submitted October 29, 2003 is improper under revised Rule 37 C.F.R. §1.121. The Examiner also noted that claim 48 appears to be currently amended but was identified as "Original". In the Amendment submitted on October 29, 2003, claims 1, 6, 21, 48, 50, 54, 71, 98 and 99 were intended to be amended. Accordingly, the status identifier for these claims has now been revised to "Currently Amended". It is now believed that the status identifiers for these claims conform to revised Rule §1.121. In view of these revisions, it is now believed that the present Revised Amendment is now in condition for consideration by the Examiner, which action is respectfully requested.

If any issues remain with regard to this Revised Amendment, the Examiner is urged to contact the undersigned at the telephone number listed below.

In the outstanding Office Action of May 29, 2003, the Examiner acknowledged the previous election of Species V: FIGURE 5, and contended that claims 54 and 61-67 are drawn to a non-elected species of the additional element of the wireless remote control, which the Examiner contends is not included in the embodiment of FIGURE 5. Applicant respectfully disagrees with the Examiner's contention. In this regard, applicant notes the following: first, only claims 54 and 64, and not claims 61-63 and 65-67 relate to a wireless remote control, and second, in the embodiment of FIGURE 5, the external control unit 10 includes a wireless remote control. In this regard, the Examiner's attention is drawn to page 16 of the application specification, and in particular, lines 10-13 and 23-28, which explain that FIGURE 5 shows an embodiment of the invention identical to that of FIGURE 4, which includes a wireless remote control of an external control unit 10, except that in the embodiment of FIGURE 5 the energy transforming device for transforming the wireless energy (from external control unit 10) into storable energy is incorporated in the implanted control unit 6. Accordingly, claims 54 and 61-67 are not drawn to a non-elected species.

It is also noted that although the Examiner contends on page 2 of the Office Action that claims 61-67 are drawn to a non-elected species, in that same paragraph the Examiner also notes that claims 61-67 have been examined. In particular, on page 7 of the Office Action, the Examiner rejected claims 61-64 under 35 U.S.C. §103(a). Notwithstanding this, on page 8 of the Office Action the Examiner then noted that claims 61-67, among others, would be allowable if rewritten in independent form. Clarification as to the status of claims 61-67 is respectfully requested.

The Examiner suggested listing the references identified in the application specification in an Information Disclosure Statement for appropriate consideration by the Examiner. These references have now been listed on a Form PTO-1449 which is being submitted with an Information Disclosure Statement that is being filed concurrently with this Amendment.

The Examiner also objected to the specification because, at page 16, line 32, reference is made to Item No. 36 in FIGURE 5, despite there being no Item No. 36 in FIGURE 5. The paragraph of the specification containing the sentence referencing Item No. 36 has now been amended to change Item No. 36 to Item No. 236, as shown in FIGURE 5.

The Examiner also objected to the specification as failing to provide proper antecedent basis for claim 39 which recited a rechargeable battery. Claim 39 has now been cancelled. Accordingly, in view of the foregoing, the Examiner's objections to the specification should now be withdrawn.

The Examiner rejected various claims pending in the application under 35 U.S.C. §102(b) or §103(a) as being anticipated by or obvious over *Lue et al.* (USP 4,739,764) alone or in combination with one or more additional references. The Examiner noted, however, that objected to claims 5, 13, 14, 18, 19, 36-39, 48, 61-67, 96 and 97 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Independent claim 1 has now been amended to include the limitations of allowable claim 5. Newly presented independent claims 249, 251, 253 and 254 are allowable dependent claims 13, 18, 48 and 96, respectively, presented in independent form to include all of such dependent claims' base claims and intervening claims. Accordingly, independent claims 1, 249, 251, 253 and 254, and all of the dependent claims which depend from them, should now be in condition for allowance.

Newly presented independent claim 100 is based on rejected claim 35. Claim 35 was rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over *Lue et al.* in view of *Benderev* (USP 5,782,745) and further in

view of *Suda et al.* (USP 5,978,712). Assuming, *arguendo*, that it would have been obvious to combine the teachings of *Lue*, *Benderev* and *Suda*, as argued by the Examiner, the resulting combination would not be the claimed invention as recited in newly presented claim 100, which is based on cancelled claim 35, because the control device of the resulting combination would not be adapted to control the external source of energy to release wireless energy for use in connection with the power of the stimulation device, as recited in claim 100 (and cancelled claim 35). *Suda's* external power source 8 is housed in a small case that may be fixed to a patient's waist with a belt or placed into a pocket of the patient's clothes. *Suda*, col. 5, lns. 8-12. Electrodes (Ea,Eb) which are connected to a stimulation output unit 2, which is housed in the small case and connected to the power source 8, are connected to a region of the patient. *See, Suda*, col. 5, lns. 4-8. Thus, *Suda's* power source does release wireless energy, as recited in claim 100.

In view of the foregoing, it is now believed that all of the claims remaining in the application, *i.e.*, claims 1, 6-34, 48-51, 54, 61-67, 71-83, 93-99 and 100-255, are now in condition for allowance, which action is earnestly solicited. If any

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issues remain in this application, the Examiner is urged to contact the undersigned
at the telephone number listed below.

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